

Art Unit 2616  
Serial No. 09/823,702

Reply to Office Action of: 01/11/2006  
Attorney Docket No.: K35A0740

### **REMARKS**

The foregoing amendments and the following remarks are responsive to the January 11, 2006 Final Office Action. Claims 1, 3, 5, 6, and 11 are amended, Claims 2, 4, 8-10, and 14 remain as originally filed, and Claims 7, 12, and 13 remain as previously presented. Thus, Claims 1-14 are presented for further consideration.

#### **Comments on Telephonic Interview on March 13, 2006**

Applicant thanks Examiner Nguyen for extending the courtesy of a telephonic conference with Applicant's representative, Bruce S. Itchkawitz, on March 13, 2006. During the telephonic conference, Claims 1 and 11 were discussed as was U.S. Patent No. 6,292,618 issued to Watanabe et al. The Examiner stated that amending Claims 1 and 11 to refer to "an external storage device" would distinguish these claims from the disclosure of Watanabe. Furthermore, the Examiner recommended that since such an amendment would require additional searching, such an amendment be filed with a Request for Continued Examination ("RCE"). Applicant's representative stated that, upon approval by Applicant, a Request for Continued Examination along with such an amendment would be filed.

#### **Response to Rejection of Claims 11-14 Under 35 U.S.C. § 112, First Paragraph**

In the January 11, 2006 Final Office Action, the Examiner rejects Claims 11-14 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. The Examiner states that the specification of the present application does not describe overlaying information to the selected program represented by the second analog signal, but that it teaches overlaying information to the digital representation of the second analog signal.

As described herein, Applicant has amended Claim 11 to recite "overlaying information to one of the selected programs represented by the digital representation of the second analog signal and a recorded program retrieved from the external storage device." Applicant submits that amended Claim 11 satisfies the enablement requirement of 35 U.S.C. § 112, first paragraph. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 11 and pass Claim 11 to allowance.

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**Response to Rejection of Claims 1-9 and 11-14 Under 35 U.S.C. § 103(a)**

In the January 11, 2006 Final Office Action, the Examiner rejects Claims 1-9 and 11-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,587,638 issued to Watanabe et al. ("Watanabe") in view of U.S. Patent No. 6,292,618 issued to Ohara et al. ("Ohara").

**Claim 1**

As currently amended, Claim 1 recites:

1. A video system for presenting content from a content provider to a user, comprising:

a tuner configured to select a program from a plurality of programs, wherein the tuner transmits a first analog signal representing the selected program via a first connection and transmits a second analog signal representing the selected program via a second connection;

an analog output port coupled to the tuner via the first connection to receive the first analog signal representing the selected program from the tuner, wherein the analog output port is configured to be connectable to an external storage device to transmit the first analog signal representing the selected program to the external storage device;

an analog signal processing circuit coupled to the tuner via the second connection to receive the second analog signal representing the selected program from the tuner and to generate a digital representation of the second analog signal;

a first interface module configured to be connectable to the external storage device to receive recorded programs from the external storage device; and

an overlay module coupled to the analog signal processing circuit and to the first interface module, the overlay module configured to selectively overlay information to a program received from one of the analog signal processing circuit and the first interface module.

The Examiner acknowledges that Watanabe fails to specifically teach that the analog signal is supplied to the storage device and to the analog signal processing circuit in two separate paths. However, the Examiner states that arranging and using another path for supplying the analog signal to the storage device merely calls for a duplication of parts. The Examiner further states that it would be obvious to one of ordinary skill in the art "to modify the apparatus of Watanabe by using an additional

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digital processing circuit for receiving the analog signal and processing the analog signal to the digital signal to be recorded by the storage device for providing multiple effect." The Examiner further acknowledges that Watanabe does not specifically teach that the input is a tuner, but that Ohara teaches a video system having a tuner, and that it would be obvious to persons skilled in the art to modify Watanabe with Ohara by using a tuner.

Applicant submits that the combination of Watanabe and Ohara does not disclose or suggest the video system recited by amended Claim 1. For example, for reasons similar to those originally submitted in the "Amendment and Response to July 27, 2005 Office Action," Applicant submits that the combination of Watanabe and Ohara does not disclose or suggest a tuner which "transmits a first analog signal representing the selected program ... and transmits a second analog signal representing the selected program," an analog output port which "is configured to be connectable to an external storage device to transmit the first analog signal representing the selected program to the external storage device," and an analog signal processing circuit which "generate[s] a digital representation of the second analog signal."

Contrary to the Examiner's characterization, Applicant submits that the video system of Claim 1 having a tuner with two connections for transmitting analog signals corresponding to the selected program is more than a mere duplication of parts as compared to Watanabe. Claim 1 recites that the tuner transmits analog signals corresponding to the selected program via two connections, and the analog signals transmitted via these two connections are treated differently by the system. As recited by Claim 1, the first analog signal transmitted via the first connection is received by an analog output port which is "configured to be connectable to an external storage device to transmit the first analog signal representing the selected program to the external storage device." Furthermore, as recited by Claim 1, the second analog signal transmitted via the second connection is received by an analog signal processing circuit which "generate[s] a digital representation of the second analog signal" which is sent to an overlay module. Thus, the configuration of the system recited by Claim 1 is not the result of mere duplication of parts; it provides additional capabilities that are not

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disclosed or suggested by Watanabe. For example, as explained in the present application at page 15, line 29 – page 16, line 5, certain embodiments of the system recited by Claim 1 allow analog signals to be sent to the external storage device (which is releasably connected to the analog output port).

For at least the foregoing reasons, Applicant submits that the combination of Watanabe in view of Ohara does not disclose or suggest all the limitations of Claim 1, and that these limitations are not mere duplication of parts. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 1 and pass Claim 1 to allowance.

#### Claims 2-9

Each of Claims 2, 4, and 6 depends from amended Claim 1, Claim 3 depends from Claim 2, Claim 5 depends from Claim 4, each of Claims 7 and 8 depends from Claim 6, and Claim 9 depends from Claim 8. Therefore, each of Claims 2-9 includes all the limitations of amended Claim 1 as well as other limitations of particular utility. For at least the reasons discussed above with respect to amended Claim 1, Applicant submits that Claims 2-9 are patentably distinguished over Watanabe in view of Ohara. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 2-9 and pass these claims to allowance.

#### Claim 11

Applicant has amended Claim 11 to recite:

11. A method of presenting content from a content provider to a user, comprising:
  - selecting a program from a plurality of programs;
  - transmitting a first analog signal representing the selected program via a first connection and transmitting a second analog signal representing the selected program via a second connection;
  - transmitting the first analog signal representing the selected program to an external storage device via an analog output for recording the selected program on the external storage device;
  - converting the second analog signal representing the selected program to a digital representation of the second analog signal; and
  - overlaying information to one of the selected program represented by the digital representation of the second analog signal and a recorded program retrieved from the external storage device.

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As discussed above, neither Watanabe nor Ohara disclose or suggest "transmitting a first analog signal representing the selected program via a first connection and transmitting a second analog signal representing the selected program via a second connection" or "providing the first analog signal ... at an analog output port ... [and] converting the second analog signal ... to a digital representation," for reasons similar to those discussed above. Furthermore, Applicant submits that the differences between Claim 11 and Watanabe are not mere duplication of parts, for reasons similar to those discussed above. Therefore, Applicant submits that amended Claim 11 is patentably distinguished over Watanabe in view of Ohara. Applicant respectfully requests that the Examiner withdraw the rejection of amended Claim 11 and pass amended Claim 11 to allowance.

Claims 12-14

Each of Claims 12 and 13 depends from amended Claim 11, and Claim 14 depends from Claim 13. Therefore, each of Claims 12-14 includes all the limitations of amended Claim 11 as well as other limitations of particular utility. For at least reasons similar to those discussed above with regard to amended Claim 11, Applicant submits that Claims 12-14 are patentably distinguished over Watanabe in view of Ohara. Applicant respectfully requests that the Examiner withdraw the rejection of Claims 12-14 and pass these claims to allowance.

**Response to Rejection of Claim 10 Under 35 U.S.C. § 103(a)**

In the July 27, 2005 Office Action, the Examiner rejects Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Ohara in further view of U.S. Patent No. 6,741,798 issued to Maruyama et al. ("Maruyama").

As described above, Applicant submits that amended Claim 1 is patentably distinguished over Watanabe in view of Ohara. Applicant submits that Maruyama does not disclose or suggest the limitations of amended Claim 1 which are not disclosed or suggested by Watanabe in view of Ohara. Therefore, Applicant submits that amended Claim 1 is patentably distinguished over Watanabe in view of Ohara in further view of Maruyama.

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Claim 10 depends from Claim 9, which depends from Claim 8, which depends from Claim 6, which depends from amended Claim 1. Therefore, Claim 10 includes all the limitations of amended Claim 1 as well as other limitations of particular utility. For at least the reasons discussed above in relation to amended Claim 1, Applicant submits that Claim 10 is patentably distinguished over Watanabe in view of Ohara in further view of Maruyama. Applicant respectfully requests that the Examiner withdraw the rejection of Claim 10 and pass Claim 10 to allowance.

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**Summary**

For the foregoing reasons, Applicant submits that Claims 1-14 are in condition for allowance, and Applicant respectfully requests such action.

The Commissioner is hereby authorized to charge payment of any required fees associated with this Communication or credit any overpayment to Deposit Account No. 23-1209.

Respectfully submitted,

Date: March 16, 2006

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